

REMARKS

Claims 10 and 11 have been amended to improve antecedent basis and not to avoid the prior art. Claim 21 has been amended to recite the claimed method in a more positive manner, and not to avoid the prior art.

The Final Office Action mailed June 16, 2003, has been received and reviewed. Claims 1 through 14 and 16 through 29 are currently pending in the application. Claims 1 through 14 and 16 through 29 stand rejected. Applicants have amended claims 10, 11 and 21 and respectfully request reconsideration of the application as proposed to be amended herein.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 5,135,485 to Cohen et al.

Claims 1 through 6, 13, 14, 16, 17, and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Cohen et al. (U.S. Patent No. 5,135,485). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With respect to claim 1, contrary to the Examiner's assertion, the electrodes 10, 12 of Cohen et al. do not have a majority of their respective areas horizontally *and* vertically offset from each other. Using the Cohen et al. drawing figures relied upon by the Examiner as examples, it can be seen that, in FIG. 2, electrodes 10 and 12 are vertically offset (one above the other) but are, in major part, horizontally overlapping. Claim 1 requires that a majority of the electrode areas be both horizontally *and* vertically offset. Similarly, FIG. 7 of Cohen et al. illustrates electrodes 10, 12 which are horizontally offset (side by side) but are, in major part, vertically overlapping. Thus, claim 1 is not anticipated. Applicants note that the *identical*

Major or

*paragraph
[0015]*

*page 9
requires that
they are preferably
Vertically spaced
and horizontally
non overlapping*

invention must be shown in as complete detail as is contained in the claim for anticipation. Thus, claim 1 is not anticipated.

Claim 2 is similarly not anticipated. The Examiner asserts a combination of Cohen et al. FIGS. 2 and 7 as anticipatory, but the claim requires that a single set of electrodes be substantially vertically *and* horizontally offset from each other. Neither FIG. 2 nor FIG. 7 meets this limitation, and the Examiner cannot combine two different embodiments of Cohen et al. to meet the claim limitation. Thus, claim 2 is not anticipated.

Claim 3 is similarly not anticipated. As with respect to claim 2, the Examiner is asserting two different drawing figures which are apparently combined in an attempt to meet the limitation of first and second electrodes being completely vertically *and* horizontally offset from each other. However, Cohen et al. does not disclose any single embodiment which meets this limitation, and the Examiner does not point out any portion of the Cohen et al. specification describing such an arrangement. Thus, claim 3 is not anticipated.

Claims 4, 5, 6, 13, 14, 16, 17 and 20 are each allowable as depending from claim 1.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,135,485 to Cohen et al. in View of U.S. Patent No. 4,201,085 to Larson

Claims 7, 8, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen et al. (U.S. Patent No. 4,201,085) in view of Larson (U.S. Patent No. 4,201,085). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 7, 8 and 12 are improper because Larson fails to remedy the deficiencies of Cohen et al. with respect to the latter's failure to meet the claim limitations of claim 1, from which claims 7, 8 and 12 each respectively depend. Thus, the combination of references fails to teach or suggest all of the claim limitations, as required. Accordingly, claims 7, 8 and 12 are not obvious over the combination of Cohen et al. and Larson.

Obviousness Rejection Based on U.S. Patent No. 5,135,485 to Cohen et al. in View of U.S. Patent No. 5,406,843 to Hannan et al.

Claims 9 through 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen et al. (U.S. Patent No. 5,135,485) in view of Hannan et al. (U.S. Patent No. 5,406,843). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants respectfully assert that the Examiner has misinterpreted the Hannan et al. reference. Specifically, Col. 9, lines 63-66 discloses providing a *timing* signal of about 2-8 Mhz to controller 16 to time its operation. In contrast, claims 9, 10 and 11 each require providing an oscillating signal to one of the first and second electrodes. Thus, in addition to not remedying the deficiencies of Cohen et al. with respect to claim 1, Hannan et al. does not, in fact, provide a teaching or suggestion of the limitations respectively set forth in each of claims 9, 10 and 11. Moreover, there is no suggestion or motivation in either of the references, or in the art as a whole, to make the attempted combination.

Obviousness Rejection Based on U.S. Patent No. 5,135,485 to Cohen et al. in View of U.S. Patent No. 3,939,360 to Jackson

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen et al. (U.S. Patent No. 5,135,485) in view of Jackson (U.S. Patent No. 3,939,360). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 18 is allowable as ultimately depending from claim 1. Jackson fails to remedy the deficiencies of Cohen et al. with respect to claim 1. Further, contrary to the Examiner's assertion, Jackson fails to teach or suggest a thin, insulative film mounting structure for the electrodes. Rather, the text relied upon in Jackson teaches the use of a plastic or silicone film or smearing petroleum jelly on the exterior of the intravenous bottle *before* applying the electrode assembly—so that moisture on the bottle doesn't short between the electrodes. Thus, claim 18 is not obvious.

Obviousness Rejection Based on U.S. Patent No. 5,135,485 to Cohen et al. in View of U.S. Patent No. 3,939,360 to Jackson and Further in View of U.S. Patent No. 5,051,921 to Paglione

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen et al. (U.S. Patent No. 5,135,485) in view of Jackson (U.S. Patent No. 3,939,360), as applied to claim 18 above, and further in view of Paglione (U.S. Patent No. 5,051,921). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants note that Paglione employs an electrode assembly disposed within a tank, and therefore in contact with the liquid within the tank. Cohen et al. and Jackson, to the contrary, place their electrode assemblies on the exterior of a container. Thus, the operative measuring technique is different in Paglione than in the two other references, and there would be no motivation or suggestion to make the asserted combination.

Obviousness Rejection Based on U.S. Patent No. 5,135,485 to Cohen et al. in View of U.S. Patent No. 5,406,843 to Hannan et al.

Claims 21 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen et al. (U.S. Patent No. 5,135,485) in view of Hannan et al. (U.S. Patent No. 5,406,843). Applicants respectfully traverse this rejection, as hereinafter set forth.

With respect to claim 21, Cohen et al. is deficient for the same reasons advanced previously with respect to claim 1. Similarly, Hannan et al. is deficient for the same reasons advanced previously with respect to claims 9-11. Further, as noted previously with respect to claims 9-11, there is no motivation or suggestion to make the attempted combination of references.

Claim 22 is allowable as depending from claim 21.

Claims 23 and 24 allowable because, as noted previously, Hannan et al. does not supply an oscillating signal of the claimed frequencies the capacitive structure as claimed, but rather uses a timing signal supplied *to* the controller.

Claims 25-29 are allowable as depending from claim 21.

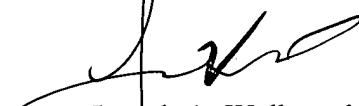
ENTRY OF AMENDMENTS

The amendments to claims 10, 11 and 21 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 1 through 14 and 16 through 29 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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